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EXAMINER	
CHENCINSKI, SIEGFRIED E	

ART UNIT	PAPER NUMBER
3628	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/751,436	SALIBA ET AL.	
	Examiner	Art Unit	
	Siegfried E. Chencinski	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2000*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. **Claims 36 and 59 are rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what kind of steps are executed by a "financial manager" since claims 11 and 27 do not recite such steps.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claims 1, 2, 8, 10-19, 25, 28, 36, 37, 39, 40, 43, 49 and 52 are rejected** under 35 U.S.C. 102(e) as being anticipated by Kolling et al. (US Patent 5,963,925).

Re. Claim 1, Kolling anticipates a method comprising:

- receiving bill data (Col. 8, ll. 52-53); and
- generating an email message with information including at least a portion of the received bill data (1. E-Mail message: Electronic Payment System (ESP) – Abstract, ll. 1-7; Col. 5, ll. 39-41; Col. 22, ll. 25-34-consumer election of address options can include an e-mail address; Col. 26, ll. 28-29; Col. 30, ll. 40-41. 2. Bill data – Col. 30, ll. 37-48),
- wherein the amount of bill data included in the email message is based, at

least in part, on an email address of a recipient (Abstract, ll. 30-31 – "any chosen medium"; Col. 9, ll. 37-55. Kolling adjusts the amount of information to fit the medium – ll. 53-54).

Re. Claim 2, Kolling anticipates a method according to claim 1, further comprising: sending the email message to the recipient (Col. 30, ll. 37-41).

- **Re. Claim 8,** Kolling et al. disclose a method according to claim 1, further comprising: receiving the sent email message including at least a portion of the bill data at the recipients email address (Col. 1, l. 26; Col. 9, ll. 15-16); and
- displaying at least a portion of the message in an inbox of an email client used by the recipient to access their email account (Col. 13, ll. 20-32; Col. 18, ll. 15-16; Col. 30, ll. 37-41).

Re. Claim 10, Kolling et al. anticipates a method according to claim 8, further comprising: paying some or all of the received bill by responding to the email (Abstract, ll. 8-9; Col. 4, ll. 30-34, 55-59).

Re. Claim 11, Kolling anticipates a data network comprising:

- a plurality of computing devices, coupled to the network, to facilitate network access by one or more participants (Col. 33. l. 43 – Col. 44, l. 33); and
- an email server, coupled to the data network and responsive to one or more of the plurality of computing devices, the data server including: a storage medium to store at least one financial account for each of the plurality of participants (Col. 33. l. 43 – Col. 44, l. 33); and
- a financial transaction manager, coupled to the memory device and selectively invoked by a participant, to manage access to and manipulation of financial account assets to effect requested financial transactions with any network participant or non-participant (Col. 34, ll. 35-67).

Re. Claim 12, Kolling anticipates a data network according to claim 11, wherein the financial account is electronically linked to an account of the participant at a financial institution (Fig. 1; Col. 4, ll. 63-65).

Re. Claim 13, Kolling anticipates a data network according to claim 12, wherein the account of the participant is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution (Col. 18, l. 58).

Re. Claim 14, Kolling anticipates a data network according to claim 11, wherein the financial account is one of a checking account, a savings account, a line of credit, and a money market account maintained by a banking institution (Col. 18, l. 58).

Re. Claim 15, Kolling anticipates a data network according to claim 11, wherein the computing devices are one or more of a personal computer, a personal digital assistant, a kiosk, a telephone and a set-top box having sufficient resources to enable the participant to access the data server and utilize the financial transaction manager (Col. 5, ll. 47-50; Col. 34, ll. 1-14).

Re. Claim 16, Kolling anticipates a data network according to claim 11, further comprising an email system having a plurality of data servers including the data server (Col. 10, ll. 32-34; Col. 14, l. 8-10; Col. 31, ll. 59-61; Col. 33, ll. 23-29).

Re. Claim 17, Kolling anticipates a data network according to claim 11, wherein the data server is controlled by a financial institution (Col. 1, ll. 11-15; Col. 5, ll. 42-53).

Re. Claims 18, Kolling anticipates a data network according to claim 11, wherein the financial transaction manager selectively transfers assets from a first participant's account to a second participant's account in response to a request by the first participant to transfer such assets (Col. 9, ll. 15-25).

Re. Claims 19, Kolling anticipates a data network according to claim 18, wherein each of the first and second participants are individual consumers, a business, or a combination of each (Col. 4, ll. 55-56, 63-64; Col. 5, ll. 21-24).

Re. Claims 25, Kolling anticipates a data network according to claim 11, wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service (Col. 9, ll. 15-25).

Re. Claims 28, Kolling anticipates a data network according to claim 25, wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant (Col. 9, ll. 15-25).

Re. Claim 36, Kolling anticipates a storage medium having stored thereon a plurality of executable instructions which, when executed, implement a financial transaction manager according to claim 11 (Fig. 17; Col. 33, l. 42 – Col. 34, l. 34).

Re. Claim 37, Kolling anticipates an email system, selectively accessed by users on a data network using a computing device, the email system comprising:

- a user interface, through which a user accesses an account associated with the user (col. 19, ll. 27-28; Col. 26, ll. 57-59; Col. 25, ll. 10-26; Col. 26, ll. 25-30);
- one or more storage devices, to store and maintain account information for each of the users (Col. 33, ll. 43-67); and
- a financial transaction manager, responsive to the user interface and coupled to the one or more storage devices, to manage access to and control assets of user accounts in response to user interaction with the user interface to enable the user to conduct financial transactions with another user or non-user of the email system (col. 34, ll. 35-67).

Re. Claim 39, Kolling anticipates an email system according to claim 37, wherein the user interface is a series of instructions issued to an email client executing on a computing device of the participant (Col. 33, l. 43 – Col. 34, l. 67).

Re. Claim 40, Kolling anticipates an email system according to claim 37, wherein the financial transaction manager selectively transfers assets from a first user's account to a second user's account in response to a request by the first user to transfer such assets (Col. 9, ll. 15-25).

Re. Claim 43, Kolling anticipates an email system according to claim 40, wherein each of the first and second users are individual consumers, or businesses (Col. 4, ll. 55-56, 63-64; Col. 5, ll. 21-24).

Re. Claim 49, Kolling anticipates an email system according to claim 37, wherein the financial transaction manager prompts a participant for payment authorization in response to a request for payment received from a network service (Col. 9, ll. 15-25).

Re. Claim 52, Kolling anticipates an email system according to claim 49, wherein the financial transaction manager transfers assets from an account specified by the user to an account specified in the request to cover the requested payment, upon authorization of the participant (Col. 9, ll. 15-25).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. **Claims 3, 4-6 & 9 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Blossman et al. (US Patent 6,721,783 B1).

RE. Claim 3, Kolling et al. do not explicitly disclose a method, wherein the step of generating comprises:

- determining whether the recipient is a participant in a secure email network; and
- constructing the email message to include at least an address of where the bill data may be confidentially viewed if the recipient is not a participant in a secure email network.

However, Blossman et al. disclose

- determining whether the recipient is a participant in a secure email network (Col. 4, ll. 1-9; Col. 15, ll. 32-35); and
- constructing the email message to include at least an address of where the bill data may be confidentially viewed if the recipient is not a participant in a secure email network (Col. 2, ll. 40-46). It would have been obvious to an ordinary practioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Blossman in order to reduce the barriers to increased usage by individuals and smaller business entities which exist in conventional

electronic bill presentment and/or payment system (Blossman et al., Col. 3, ll. 55-58).

Re. Claim 4, Kolling et al. do not explicitly disclose a method, further comprising: constructing the email message to include substantially all of the bill data along with financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account. However, Blossman et al. disclose a method according to claim 3, further comprising: constructing the email message to include substantially all of the bill data along with financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account (Col. 4, ll. 41-44, 50-55; Col. 12, ll. 14-47). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Blossman et al. in order to send electronically-mailed financial billing and statement notices or advices and mandated periodic statements, securely or privately (Blossman et al., Col. 3, ll. 55-58).

Re. Claim 5, Kolling et al. disclose a method, wherein the MIME elements enable the recipient to pay all or part of the received bill (Col. 3, ll. 14-16. A bill can be paid once it is received by the payer, especially when there is confidence in the integrity of the statement data.).

Re. Claim 6, Kolling et al. disclose a method, wherein the MIME elements enable the recipient to establish and manage a financial account (The security features of the MIME elements create greater confidence in the data and in the integrity of the transmissions, thus encouraging the recipient to make a return transmission with payment information).

Re. Claim 9, Kolling et al. disclose a method, further comprising: displaying the email message in the email client of the recipient, upon user access of the email message, that enable the recipient to pay some or all of the received bill (Abstract, ll. 8-9; Col. 4, ll. 30-34, 38-41, 55-59). Kolling et al. do not explicitly disclose a method wherein the email message includes financial Multipurpose Internet Mail Extension (MIME) elements. However, Blossman et al. disclose a method according to claim 3, further comprising: constructing the email message to include substantially all of the bill data along with

financial Multipurpose Internet Multimedia Extensions (MIME) elements which enable the recipient to manage a financial account (Col. 4, ll. 41-44, 50-55; Col. 12, ll. 14-47). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Blossman et al. in order to send electronically-mailed financial billing and statement notices or advices and mandated periodic statements, securely or privately (Blossman et al., Col. 3, ll. 55-58).

4. **Claims 26, 27, 38, 50, 51 & 59 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Cornelius et al. (US Patent 6,629,081).
Re. Claims 26&27, Kolling et al. do not explicitly disclose a data network, and an e-mail system, wherein the network service is

- **Re. Claims 26 and 50,** an electronic auction service.
- **Re. Claims 27 and 51,** an electronic retail service.
- **Re. Claim 38,** an email system, wherein the user interface is series of instructions issued to a computing device of the user to create a web page at the computing device.

However, Cornelius et al. disclose a data network wherein the network service is

- an electronic auction service (Fig. 8; Col. 18, ll. 13-19).
- an electronic retail service (Fig. 3, Col. 3, ll. 65-67).
- an email system wherein the user interface is a series of instructions issued to a computing device of the user to create a web page at the computing device (Col. 192, ll. 21-39; Col. 216, ll. 3-63).

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Cornelius et al. in order to provide improved statement or billing delivery means to leverage existing systems (such as existing electronic bill payment systems) to participants in a transaction (Kolling et al., Col. 4, ll. 2-6).

Re. Claim 59, Kolling et al. disclose a storage medium having stored thereon a plurality of executable instructions which, when executed, implement an email system (Fig. 17; Col. 33, l. 42 – Col. 34, l. 34).

5. Claims 29, 31, 53 & 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Ganesan (US Patent 6,678,664 B1).

Re. Claims 29 & 53, Kolling et al. do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment. However, Ganesan discloses a data network wherein the financial transaction manager determines whether to honor the participants payment when the specified account has insufficient assets to cover the requested payment (Col. 18, ll. 5-23). Ganesan discloses the standard practice of honoring a check if adequate prior credit arrangements are made. In the electronic banking era these facilities include a line of credit or a credit card account of the payer arranged with the financial institution to back up a payment account such as a checking account. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Ganesan in order to reduce, if not eliminate the barriers to increased usage by individuals of electronic bill presentment and/or payment systems (Ganesan Col. 4, ll. 11-15).

Re. Claims 31&55, Kolling et al. do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment. However, Ganesan discloses a data network wherein the financial transaction manager automatically accesses a line of credit associated with the participant to honor the payment when the specified account has insufficient assets to cover the requested payment (Col. 18, ll. 5-23). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of Ganesan in order to reduce, if not

eliminate the barriers to increased usage by individuals of electronic bill presentment and/or payment systems (Ganesan Col. 4, ll. 11-15).

6. **Claim 32 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. and Ganesan as applied to claim 31 above, and further in view of Blossman et al. **Re. Claim 32,** neither Kolling et al. nor Ganesan explicitly disclose a data network, wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to honor the requested payment. However, Blossman et al. discloses a data network wherein the financial transaction manager notifies the participant of the insufficient funds and that the line of credit has been accessed to honor the requested payment (Col. 9, ll. 11-27). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. and Ganesan with that of Blossman et al. in order to send electronically mailed bank advices of electronic bill presentment and/or payment systems events to individuals (Blossman et al. Col. 3, ll. 55-58).

7. **Claims 30 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. and Ganesan as applied to claim 29 above, and further in view of McCoy et al. (US Patent 5,649,116).
Re. Claim 30, neither Kolling et al. nor Ganesan explicitly disclose a data network and an e-mail system, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment. However, McCoy et al. disclose a data network wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment (Abstract ll. 8-14). McCoy teaches a formula-based threshold for honoring a payment request when an account has insufficient assets to cover a requested payment. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of

Kolling et al. and Ganesan with that of McCoy et al. in order to control risk in an automated electronic payment system (McCoy et al., Col. 2, l. 66 – Col. 3, l. 1).

7. **Claim 54 is rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of McCoy et al. (US Patent 5,649,116).

Re. Claim 54, Kolling et al. do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment. However, McCoy et al. disclose a data network wherein the financial transaction manager utilizes a growing trust model to determine whether to honor the payment when the specified account has insufficient assets to cover the requested payment (Abstract ll. 8-14). McCoy teaches a formula-based threshold for honoring a payment request when an account has insufficient assets to cover a requested payment. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. with that of McCoy et al. in order to control risk in an autornated electronic payment system (McCoy et al., Col. 2, l. 66 – Col. 3, l. 1).

8. **Claims 22, 23, 46 & 47 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Weatherly et al. (US Patent 6,049,784).

Re. Claims 22,23,46&47, Kolling et al. disclose financial transactions with financial institutions such as banks and brokerage firms and the financial activities consumers engage in therewith (Col. 1, ll. 26-27; Col. 3, l. 20; Col. 5, ll. 50-51). Kolling et al. do not disclose

- **Re. Claims 22&46,** a data network and an e-mail system, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant.
- **Re. Claims 23&47,** a data network and an e-mail system, wherein the assets are received from a brokerage at the request of the participant.

However, Weatherly et al. disclose

- **Re. Claims 22&46,** a data network, wherein the financial transaction manager selectively receives assets for deposit in an account of a participant (Col. 5, ll. 51-56).
- **Re. Claims 23&47,** a data network, wherein the assets are received from a brokerage at the request of the participant (Col. 5, ll. 51-56).

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have recognized that electronic deposits can be arranged to be made by or on behalf of any party, including individuals and businesses, and in recognition, to have combined the art of Kolling et al. with that of Weatherly et al. in order to send electronically-mailed remittances in an efficient, reliable and timely manner (Weatherly et al., Col. 13, ll. 39-42).

9. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Blossman as applied to claim 3 above, and further in view of Cornelius et al. (US Patent 6,629,081) and Kahn et al. (US Patent 6,401,079 B1).

Re. Claim 7, neither Kolling et al. nor Blossman explicitly disclose a method, wherein the step of determining comprises:

- identifying a domain name from the email address; and
- cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network.

However, Cornelius et al. disclose a method, wherein the step of determining comprises: identifying a domain name from the email address (Col. 24, ll. 10-24); and Kahn et al. disclose a method of cross referencing the identified domain name against a list of secure domain names to determine whether the recipient belongs to a secure email network (Col. 22, ll. 15-24).

It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. and Blossman with that of Cornelius et al. and Kahn et al. in order to help keep customers' billing data secure in a computer automated billing method.

10. Claims 24 & 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Weatherly as applied to claims 22 & 46 above, and further in view of Kahn et al. (US Patent 6,401,079 B1).

Re. Claims 24&48, neither Kolling et al. nor Weatherly explicitly disclose a data network and an e-mail system wherein the assets are received from an employer as compensation to the participant. However, Kahn et al. disclose a network wherein the assets are received from an employer as compensation to the participant (Col. 12, ll. 5-10). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. and Weatherly with that of Kahn et al. in order to offer customers a computer automated financial management system which also provides employers with the flexibility and control of an automated standalone payroll system (Kahn et al. Col 4, ll. 64-67).

11. Claims 20, 21, 44 & 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Slotznick (US Patent 5,983,200).

Re. Claims 20, 21, 44 & 45, Kolling does not explicitly disclose

- **Re. Claims 20&44,** a data network and an e-mail system, wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants.
- **Re. Claims 21&45,** a data network and an e-mail system, wherein the second participant is identified by one of a name, an alias, or an email address.

However, Schlotznick discloses a data network wherein the first participant does not have a priori knowledge of the second participant's account information, but identifies the second participant from a list of network participants (Col. 18, ll. 34-36, 51-52); and a data network according to claim 20, wherein the second participant is identified by one of a name, an alias, or an email address (Col. 18, ll. 34-52). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. and Slotznick because Kolling specifically calls for

incorporating Hilt et al. into Kolling's teaching to speed the execution of many tasks (Slotznick Col. 3, ll. 48) in the providing of full-circle electronic financial transactions for billers and consumers (Kolling Col. 4, ll. 36-38).

12. Claims 33, 41, & 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Kahn et al.

Re. Claims 33, 41 & 56, Kolling et al. do not explicitly disclose a data network and an e-mail system, wherein the financial transaction manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant. However, Kahn et al. disclose a data network and e-mail system wherein the financial transaction manager issues an instruction to have a check issued and sent to an address specified by the request, upon authorization of the participant where the participants are an employer, a payment service, the employer's bank and the employee payee who can receive a paper check instead of an electronic payment which is authorized by the employer payer (Col. 12, l. 61 – Col. 13, l. 8). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the art of Kolling et al. and Kahn et al. to provide flexibility in the making of an automated payment (Kahn et al., Col. 4, ll. 64-67).

13. Claims 34 & 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. and Kahn et al. as applied to claim 33 above, and further in view of Wells Fargo Online (See item U. in USPTO Form 892).

Re. Claim 34&57, neither Kolling et al. nor Kahn et al. explicitly disclose a data network and an e-mail system wherein the issued check includes a uniform resource locator (URL) address of a web page offered by the data server where the recipient can establish an account. However, Wells Fargo Online discloses since 1997 the inclusion of a URL where the recipient can establish an account. The enclosed screen shots from Wells Fargo Online's URL are dated 1998. The Examiner has been doing business with Wells Fargo Bank in the San Francisco area since 1991 and has personally received a wide variety of WFB promotional material, computer printed statements, business cards

and letterhead in the mail, at bank branches and from bank employees with the URL imprinted on them at least since the late 1990's. URL's became a standard component of contact information in American business, including in banking, during the 1990's. A bank issuing payroll checks would be a bank where the recipient could establish an account. It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have included a bank's URL with a bank's address information on electronic or paper checks to convey a means of contact which has become increasingly popular in banking and the general business community during the 1990's in order to attract some of the growing millions of computer users to online banking with its own institution by presenting a convenient opportunity to do so.

14. Claims 35, 42 & 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. in view of Kahn et al. as applied to claims 34 & 41 above, and further in view of Krishan et al. (US Patent 6,442,529 B1).

Re. Claim 35, 42 & 58, neither Kolling et al. nor Kahn et al. disclose a data network and an e-mail system, wherein the check includes an offer of free assets, credited to a newly established account created by the recipient of the check. However, Krishan et al. disclose the long established practice of offering a free service product as an incentive for a prospect to try a service (Front Page, OTHER PUBLICATIONS: Simon Debartol, "Microsoft to Offer Free Internet to 32 Million Michigan Households", Indianapolis Star and News, Dec. 02, 1997.). It would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the teachings of Kolling et al. and Kahn et al. with the teaching of Krishan et al. in order to include the printing of an offer of free assets on a check, credited to a newly established account created by the recipient of the check as a method of providing advertising and information content on a user's desktop screen (Krishan et al. Col. 3, ll. 16-18).

Conclusion

15. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is 703-305-6199. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsucccessful, the Examiner's supervisor, Hyung S. Sough, can be reached on 703- 308-0505.
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.
Any response to this action should be mailed to:

Commissioner of Patents and Trademarks Washington D.C. 20231

or faxed to:

(703)872-9306 [Official communications; including After Final communications labeled "Box AF"]

(703) 746-9601 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2411 Crystal Drive, Arlington, VA, 7th floor receptionist.

SEC
May 24, 2004

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